

**REMARKS/ARGUMENTS**

**STATUS OF THE CLAIMS**

The Office Action dated July 1, 2004 has been received and its contents carefully considered. Claims 1-5, 7-12, 14-16, 19 and 20 are pending. Claims 1-5, 7-12, 14-16, 19 and 20 have been rejected. Claims 1, 9 and 16 have been amended.

Applicants thank the Examiner for the interview held on July 28, 2004. Agreement was reached in that the cited prior art does not teach the claimed features of the present invention including, for instance, details regarding the restricting device in relationship the second elongated member.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

**OFFICE ACTION**

Claims 1-4, 7-8, 16 and 19-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sorenson. Without conceding the propriety of the rejection, independent claims 1 and 16 have been amended. It is respectfully submitted that Sorenson does not teach, *inter alia*, an extensible handle comprising a hollow second elongated member wherein “in order to prohibit movement in an actual direction, the first end is retained along a surface of the outer end face and abutting contact with the restricting device” as recited in claim 1 and similarly in claim 16.

In the previous Office Action, the Examiner regards a first elongated member as an inner telescoping tube element 26 and a second elongated member as an outer tube 32 including a forward end portion 54 denoted by Sorenson. The Examiner further considers a restricting

device as item 80 (denoted as a lock assembly by Sorenson). As shown, for instance, in FIGS. 5 and 6, Sorenson teaches away from the present invention because the lock assembly 80 (considered as the restricting device of the present invention by the Examiner) merely abuts an inner surface of the forward end portion 54 (considered as the second elongated member of the present invention by the Examiner). The structure of Sorenson is altogether different from the claimed invention, because Sorenson does not teach that a first end is retained along a surface of the outer end face in abutting contact with the restricting device as recited in claims 1 and 16 of the present invention.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claims, is not found either expressly or inherently described as required by the M.P.E.P., Sorenson cannot be said to anticipate the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 2-3 and 7-8 ultimately depend from independent claim 1 and are patentable over the cited prior art for at least the same reasons as is claim 1.

Claims 19-20 depend from independent claim 16 and are patentable over the cited claim prior art for at least the same reasons as is claim 16.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sorenson as applied to claims 1-4, 7-8, 16 and 19-20 in view of Messier. Claim 5 depends from independent claim 1. As previously presented, Sorenson does not teach, *inter alia*, an extensible handle comprising a hollow second elongated member wherein “in order to prohibit movement in an

axial direction, the first end is retained along a surface of the outer end face and abutting contact with the restricting device” as recited in claim 1. Messier does not cure the deficiencies of Sorenson because it, too, lacks a teaching of prohibiting movement in an axial direction such that the first end is retained along a surface of the outer end face and in abutting contact with the restricting device as claimed by the present invention.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Therefore, since the prior art lacks all the claimed features, Sorenson, alone or in combination with Messier, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 9-12 and 14-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tallman in view of Sorenson. Without conceding the propriety of the rejection, independent claim 9 has been amended. It is respectfully submitted that Tallman does not teach, *inter alia*, an apparatus for moving an item comprising a second elongated member wherein “in order to prohibit movement in an axial direction, the first end of the second elongated member is retained along a surface of the outer end face and abutting contact with the restricting device” as recited in claim 9.

The Examiner concedes that Tallman does not disclose a handle as recited by the present invention (see pg. 4, 1st para. of the previous Office Action). Sorenson does not cure the

deficiencies of Tallman because, it, too, does not teach the first end of the second elongated member retained along a surface of the outer end face and abutting contact with the restricting device as claimed by the present invention. Therefore, since the prior art lacks all the claimed features, Tallman, alone or in combination with Sorenson, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 10-12 and 14-15 ultimately depend from independent claim 9 and are patentable over cited prior art for at least the same reasons as is claim 9.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'Marc W. Butler', with a long horizontal flourish extending to the right.

Marc W. Butler  
Registration No. 50,219

Date: 8/18/04  
Washington Square, Suite 1100  
1050 Connecticut Avenue, N.W.  
Washington, D.C. 20036-5304  
Telephone: 202-861-1500  
Facsimile: 202-861-1783